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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Municipal Capital Markets Corporation

Serial No. 74/469,155

Michael Schwarz of Akin, Gump, Strauss, Hauer & Feld for
Municipal Capital Markets Corporation

Paul F. Gast, Trademark Examining Attorney, Law Office 106
(Mary Sparrow, Managing Attorney)

Before Simms, Cissel and Hanak, Administrative Trademark
Judges.

Opinion by Hanak, Administrative Trademark Judge:

Municipal Capital Markets Corporation (applicant)
seeks to register COOPERSTOWN in typed drawing form for
"restaurant services." The intent-to-use application was
filed on December 13, 1993.

The Examining Attorney has refused registration
pursuant to Section 2(e)(3) of the Lanham Trademark Act on

the basis that applicant's mark "is primarily geographically deceptively misdescriptive as applied to the involved services." (Examining Attorney's supplemental brief page 1).¹

When the refusal was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs and were present at a hearing held on March 26, 1998.

Applicant is a Texas corporation headquartered in Dallas. Applicant "does not dispute the fact that Cooperstown [New York] is a place known generally to the public." (Applicant's supplemental brief page 3). Moreover, applicant acknowledges that "the Examining Attorney has compiled a large number of extracts from newspapers and magazines which show that there are restaurants in Cooperstown. That fact is beyond dispute." (Applicant's supplemental brief page 6). However, applicant states that the "Examining Attorney has failed to prove that Cooperstown is known for its restaurants or any particular restaurant cuisine such that the public would assume that applicant's restaurant services originate in Cooperstown." (Applicant's supplemental brief page 6).

¹ Pursuant to a Board order dated March 18, 1996, this case was remanded to the Examining Attorney. Both applicant and the

In response, the Examining Attorney does not dispute this latter statement. Rather, it is the position of the Examining Attorney that he need not present such proof in order to establish that applicant's mark is primarily geographically deceptively misdescriptive. (Examining Attorney's supplemental brief page 3).

Our primary reviewing Court has set forth a two-part test for determining whether a mark is primarily geographically deceptively misdescriptive. See In re Jacques Bernier Inc., 894 F.2d 389, 13 USPQ2d 1725, 1726 (Fed. Cir. 1990):

To establish a prima facie case for refusal to register a mark as "primarily geographically deceptively misdescriptive," it is not sufficient for the Patent and Trademark Office (PTO) to establish simply that the mark is the name of a place known generally by the public. ... The PTO also must establish that "the public associates the goods [or services] with the place which the mark names."

Putting aside the first part of this two-part test, the issue before us becomes whether the Examining Attorney has satisfied the second part. We find that he has not, and accordingly reverse the refusal to register.

It is beyond dispute that restaurant services are some of the very most ubiquitous of all types of services. Virtually every town in America has at least one

Examining Attorney filed initial and supplemental briefs.

restaurant, and most towns (not to mention cities) have numerous restaurants. For example, Cooperstown, New York -- a town of approximately 2,500 residents -- has about a dozen restaurants, according to the evidence of record.

Given the ubiquitous nature of restaurant services, applicant argues that if "COOPERSTOWN could not be registered as a service mark for restaurants," then "there would now be a new per se rule that the name of a well-known town can never be registered as a service mark for restaurants," even if there is no evidence whatsoever showing that restaurant services or a particular cuisine were associated by the public with that town. (Applicant's supplemental brief page 8). In response, the Examining Attorney does not really take issue with applicant's contention that for the Board to affirm the refusal to register, it might be establishing such a per se rule. Indeed, the Examining Attorney states that "if ever there were an area [restaurant services] in which the court [Board] might like to establish a 'per se' rule that applicant accuses the Examining Attorney of fostering, this might be it." (Examining Attorney's supplemental brief page 2).

In order to prove the second prong of the primarily geographically deceptively misdescriptive test (i.e., the

goods or services/place association), the Examining Attorney must present evidence that does something more than merely establish that services as ubiquitous as restaurant services are offered in the pertinent geographic location. For example, in Jacques Bernier, the Court -- in reversing a refusal to register RODEO DRIVE for perfume -- stated that the fact "that [other] perfume is associated with [sold on] ... Rodeo Drive [is] too insubstantial and tenuous a basis to support the Board's conclusion that the use of the mark RODEO DRIVE on [applicant's] perfume would suggest to consumers that the perfume is sold on Rodeo Drive." 13 USPQ2d at 1727.²

In this case, the Examining Attorney has simply failed to present "that something more" which is required to satisfy the services/place association prong of the two-part test. The Examining Attorney has made of record no evidence that anyone travels to Cooperstown, New York for its food. The Examining Attorney has made of record no evidence that Cooperstown, New York is associated with a

² The dissenting judge argues that the facts of the present case and those of Jacques Bernier are "in stark contrast." We disagree. While the Court in Jacques Bernier stated that "there is no indication that any perfume is manufactured or produced on Rodeo Drive" (13 USPQ2d at 1727, emphasis added), there was no dispute as to the obvious -- namely, that some perfume (but not applicant's) was sold on Rodeo Drive. Thus, just as it was obvious that perfume is sold on Rodeo Drive, it is likewise

particular type of food or cuisine. To be perfectly clear, we are not saying that the Examining Attorney had to prove that Cooperstown, New York is well known for its restaurants, food or cuisine. However, as was the case in Jacques Bernier, the mere fact that restaurant services are offered in Cooperstown, just like the mere fact that perfume is sold on Rodeo Drive, is simply not sufficient by itself to establish the requisite goods or services/place association. For example, an Examining Attorney could satisfy the services/place association by presenting evidence showing that a town or city had somewhat greater numbers of restaurants offering a particular type of cuisine than normally would be expected for a town or city of that size.

One final comment is in order. In this case, applicant advanced a second argument as to why its mark COOPERSTOWN for restaurant services is not primarily geographically desceptively misdescriptive. According to applicant, "when the average American sees the name COOPERSTOWN, one thing springs to mind -- the Baseball Hall of Fame. In fact, as shown by the Dickson Baseball Dictionary, Cooperstown is "a synonym for the Hall [of

obvious that restaurant services are sold in virtually every town in America.

Fame] itself." (Applicant's supplemental brief page 8). Quoting from Jacques Bernier, 13 USPQ2d at 1727, applicant made the following comments at page 9 of its supplemental brief: "A geographic mark may indicate that a product is stylish or of high quality, i.e., HYDE PARK or NANTUCKET for clothing, and FIFTH AVENUE for a car." Continuing at page 10 of its supplemental brief, applicant argues that like HYDE PARK, NANTUCKET and FIFTH AVENUE, its mark COOPERSTOWN is not primarily geographically deceptively misdescriptive because "COOPERSTOWN symbolizes the Baseball Hall of Fame -- more than just a [geographic] place."

Indeed, even the Examining Attorney stated "that the name in the proposed mark [COOPERSTOWN] is known as essentially a shrine dedicated to baseball." (Examining Attorney's initial brief page 6, emphasis added).

I find applicant's second argument to be convincing. To most Americans residing outside of Central New York, "Cooperstown" signifies primarily not a geographic location, but rather an institution, namely, the Baseball Hall of Fame. However, suffice it to say that Judge Simms does not share my view regarding applicant's second argument. Accordingly, I initially prepared this opinion setting forth only applicant's first argument, which, like Judge Simms, I agree with. However, because the dissenting

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judge has raised and rejected applicant's second argument,
I feel compelled to note that I find it convincing.

Decision: The refusal to register is reversed.

E.W. Hanak
Administrative Trademark
Judge, Trademark Trial
and Appeal Board

Simms, Administrative Trademark Judge, concurring:

I agree with the conclusion of Judge Hanak that the Examining Attorney has not established a services/place association by the public in this case, and agree that this refusal should therefore be reversed. It might be helpful to point out, however, that if this applicant had sought registration for the mark COOPERSTOWN, which name is indisputably associated by many with the National Baseball Hall of Fame located in Cooperstown, New York, for, say, baseballs, bats, gloves, or baseball memorabilia of one type or another, there would in my view be a goods/place association established under relevant case law.³ However,

³ As noted by Judge Hanak, I believe that the term Cooperstown has *primary* geographic significance. This record, largely established by the Examining Attorney in an attempt to show a services/place association, does not, in my view, support applicant's argument that the term has lost its primary geographic meaning. See *In re Opryland USA Inc.*, 1 USPQ2d 1409 (TTAB 1986) ("Nashville" primarily geographically descriptive even though "Nashville" has other connotations, such as country music. "Because a term may have other meanings does not necessarily alter the primacy of its geographical significance.") In the numerous excerpts from newspaper articles offered by the Examining Attorney, there is no clear reference showing "Cooperstown" as a shorthand reference to the Baseball Hall of Fame. Rather, these articles are about the town of Cooperstown. The only evidence in support of applicant's argument that "Cooperstown" has lost its primary geographic significance is a definition of "Cooperstown" from a reference, mentioned by Judge Hanak, entitled The Dickson Baseball Dictionary (1989), which indicates on the cover that it contains "5000 Terms Used By Players, The Press And People Who Love The Game." That definition of "Cooperstown" states:

New York State home of the Baseball Hall of Fame. The name of the town is used as a synonym

as Judge Hanak has indicated, and as applicant has argued, the mere fact that there are restaurants in Cooperstown is, in view of the nature of these services, not sufficient to establish a services/place association. I simply do not believe that the average member of the general public associates Cooperstown with restaurant services. There is no evidence, for example, that Cooperstown is associated with any particular type of cuisine or manner of food preparation. Compare, *In re California Pizza Kitchen Inc.*, 10 USPQ2d 1704 (TTAB 1989). However, if evidence submitted by applicant in connection with its statement of use demonstrates that applicant's restaurant or restaurants have a baseball motif or theme and/or that its menu items are baseball-themed, the Examining Attorney may, in my opinion, again refuse registration under Section 2(e)(3) on the basis that the record now shows that a services/place association exists between (baseball-themed) restaurant services and Cooperstown.

R. L. Simms
Administrative Trademark
Judge, Trademark Trial
and Appeal Board

for the Hall itself: "If he stays healthy, Dwight's on his way to Cooperstown." (Gary Carter on Dwight Gooden in *Newsweek*, September 2, 1985)

Cissel, Administrative Trademark Judge, dissenting:

I respectfully dissent. I would affirm the refusal to register because it is justified in light of the statute and the existing legal precedent. I find no basis in law or reason for the majority's requirement for the Examining Attorney to present evidence beyond what is already of record. This evidence establishes that "COOPERSTOWN" is recognized as the name of a place which is neither remote nor obscure, and it establishes that prospective purchasers of restaurant services would make an association between the place and such services, notwithstanding the fact that Cooperstown is not famous for, or even well known for, either restaurants or a particular type of cuisine. Contrary to the implication of the majority, whether or not people travel to Cooperstown for its food is totally irrelevant.

It is improper and unreasonable to burden the Examining Attorney with trying to divine what the majority means when it requires submission of "that something more" in addition to the well known requirements for establishing that a mark is primarily geographically deceptively misdescriptive. An association between the services and the place named by the mark has been found when, as in the

instant case, the Examining Attorney has shown that the name in question identifies a geographic place, and that goods or services of the kind specified in the application are known to emanate from that place. In re Handler Fenton Westerns, Inc., 214 USPQ 848 (TTAB 1982).

Applicant and the Examining Attorney devoted significant argument to the issue of whether or not the primary significance of "COOPERSTOWN" is geographic in light of the evidence that the name is sometimes used in reference to the Baseball Hall of Fame, which is located in Cooperstown, New York. Contrary to the opinion of Judge Hanak, in my view, the evidence of record does not establish that the primary significance of the name "Cooperstown" is not geographic. Although some of the evidence on this point is ambiguous, for the most part, it shows "Cooperstown" used to designate the place where the tourist attraction is located. The primary significance of the term is therefore still geographic.

The central focus of the majority opinion seems to be on the question of whether an association between the services and the place would be made. The majority appears to be troubled by its understanding that restaurant services are available virtually everywhere, or at least in every municipality the size of Cooperstown, New York.

This may or may not be a fact of which we may take judicial notice, but even if it were established by the record in this case, it would not change my analysis or my decision. Stepping back in order to gain perspective on this issue, I note that the reasoning behind the section of the Act barring registration, in the absence of proof of acquired distinctiveness, of geographically descriptive marks, is to allow all the merchants in a particular area the free use of the name of the place in which they do business. In this regard, whether or not the goods or services in question are commonly available in other areas has never been enunciated as a concern. From my perspective, this should not become a factor now.

The majority appears to place great weight on the Court's holding in *In re Jacques Bernier Inc.*, 13 USPQ2d 1727 (Fed. Cir. 1990). That case, however, is readily distinguishable from the case at hand. There, in finding that the mark "RODEO DRIVE" for perfume did not run afoul of Section 2(e)(2) of the Act, the Court noted (at p. 1727) that "[n]othing in the record, however, indicates or even suggests that the consuming public would believe that Rodeo Drive was the place of manufacture or production of the perfume. Indeed, there is no indication that any perfume is manufactured or produced on Rodeo Drive." Further, as

the majority noted, the Court concluded that the evidence before it in that case was "too insubstantial and tenuous" a basis upon which to support the conclusion that the use of the applicant's mark on perfume would suggest to consumers that the perfume was even sold on Rodeo Drive. In stark contrast, the record in the instant application clearly demonstrates that services of the kind applicant intends to render under its proposed mark are in fact marketed and rendered in the place named by the mark. That this might also be so for a large number of other places does not trouble me in the least.

A brief comment with respect to the concurring opinion is also in order. I do not understand how "it might be helpful to point out, however, that if this applicant had sought registration for the mark COOPERSTOWN, which name is indisputably associated by many with the National Baseball Hall of Fame located in Cooperstown, New York, for, say, baseballs, bats, gloves, or baseball memorabilia of one type or another, there would in my view be a goods/place association established under relevant case law."

This statement appears to be predicated on the conclusion that the name "Cooperstown," when used in connection with the enumerated baseball-related products, has a connotation that is not primarily geographical, but

rather that it would create an association with the Baseball Hall of Fame.

Unless the primary connotation of the term in question is that of a place, however, we do not even get to the second prong of the test for registrability under Section 2(e)(3) of the Act. That is to say, if the term, when used in connection with baseball memorabilia, for example, would be perceived as creating an association with the Hall of Fame, the term could not be said to possess significance which is primarily geographic. That people would associate such baseball-related products with the Hall of Fame would therefore not be a goods/place association. Instead, the association would be between the goods and the Hall of Fame. While this hypothetical scenario might raise the possibility of a refusal to register under Section 2(a) of the Act, which bars registration of matter which may falsely suggest a connection with an institution, it would not bring Section 2(e)(3) into play, and would therefore not be analogous to the facts before us at this juncture in the case at hand.

In summary, the imposition of the additional requirement for evidence of a nebulous "something more" to the well settled test for geographic descriptiveness or misdescriptiveness is without any proper basis. What was

missing in the Bernier case, supra, was evidence showing that the goods in question emanated from, or were sold in, the place named by the mark, so that there would be a basis for concluding that purchasers would make an association between the place and the goods. In the case now before the Board, we have such evidence. The Examining Attorney has met his burden in supporting his refusal to register in the case at hand, and the refusal should be affirmed.

R. F. Cissel
Administrative Trademark Judge,
Trademark Trial & Appeal Board